

**REMARKS**

This Amendment is in response to the Official Action mailed December 10, 2007. Claims 31, 35, 41, 52, 53, 58, 63, 68 and 69 have been amended. Claims 36-39, 45-46 and 54-57 have been cancelled. Claims 31-35, 41-44, 52-53 and 58-72 remain pending and are presented for consideration in view of the above amendments and following remarks.

**Informalities**

Applicants have made minor changes to the preambles of claims 31, 41, 52, 53, 58 and 63 based on the informalities noted by the Examiner. Applicants have also deleted the unintended redundant language in claim 31. Applicants therefore request that the objections to the claims based on informalities now be withdrawn.

**Group A Claims (Independent Claims 31, 41, 68, 69)**

The Examiner has rejected all of the independent claims of Group A (i.e., claims 31, 41, 68 and 69), and their dependent claims 32-34, 40, 42-46 and 70, as obvious over Sparks and Ohara, two previously cited references, in view of another new reference, Akamatsu et al., U.S. Patent No. 7,224,886 ("Akamatsu"). Dependent claims 40 and 45-46 have now been cancelled.

The combination of these three references, however, does not produce all of the claimed features of the Group A claims. In particular, neither Akamarsu, nor Ohara nor Sparks, alone or in combination, teach or disclose the claimed features of the receiving apparatus (e.g., the IRD) of claim 31, including:

a format converter circuit for outputting the decoded broadcasting signal from said receiving apparatus in a format for display on a monitor to a

user; and

a display processing circuit for displaying control panel information for allowing station selection and recording and reproduction control of a program recorded on a recording medium loaded in said external reproducing apparatus by a predetermined format,

wherein when said external recording apparatus is in the analog reproducing mode, *said display processing circuit prevents said format converter circuit from outputting the decoded broadcasting signal to the user*, and when said external recording apparatus is in the analog recording mode, *said display processing circuit prevents said format converter circuit from outputting the decoded broadcasting signal from said format converter circuit only during the displaying of said control panel information ....*

or claim 41 of:

wherein when said external recording apparatus is in the analog recording mode, *said display processing circuit prevents said format converter circuit from outputting the decoded broadcasting signal from said format converter circuit only during the displaying of said control panel information.*

With respect to the "wherein when said external recording apparatus is in the analog reproducing mode ..." limitation from the Group A claims previously presented, the Examiner has relied on Ohara and Sparks (see pages 3-4 of the Official Action) for disclosing this limitation. But as explained below, neither reference taken alone or combined discloses the currently claimed feature.

First, Ohara does not provide a display processing circuit within the IRD 200 for preventing a format converter circuit within the IRD 200 from outputting the decoded

*broadcasting signal to the monitor of a user when the external VTR is in an analog reproducing mode, or when the VTR is in an analog recording mode but only during the displaying of said control panel information.*

Rather, in one set of embodiments, Ohara's change-over switches 13 are located within the VTR 100 and only output a video signal from the VTR 100 at terminals 16, outputting either the video signal from IRD 200 input via input 10 or the analog signal input into the VTR via input 11.

Still further, to the extent that a user would (or could even be able to) hook up the output terminals 204 of the IRD directly to a user's monitor, there would still be no circuitry within the IRD 200, or even within the VTR 100, that would prevent Ohara's decoder 203 within the IRD 200 from outputting the digital broadcasting signals received from input 201 and tuner 202 to the user.

In the other set of embodiments of Ohara where the VTR 100 includes IRD circuitry within the VTR, there is no display processing circuit in Ohara that prevents the display of the digital decoded broadcasting signal while the VTR is in the analog recording mode let alone preventing the display of the decoded broadcasting signal from a format converter circuit during the displaying of control panel information.

Second, in Sparks, in its analog recording mode, the DVCR 200 records analog input signals. It can then output such analog signals to the display 300. In the digital recording mode, the DVCR 200 records digital input signals in digital form. It can then output such digital signals to IRD 100 where they are decoded and placed into analog form for display on display 300. In either case, on-screen display (OSD) information can be mixed in with the signal, either by the DVCR 200 or IRD 100, to be output to the display 300.

However, when Sparks is in the analog recording mode, there is no prevention of the display of the A/V OUT signal 101 *when control panel (or OSD) information is displayed*. Again, this is because Sparks, like Ohara, does not address the problem solved by Applicants; namely, that users may become confused if they try to record a digital broadcasting signal *being decoded and viewed* using a combined external digital/analog recording device, when that combined recording device is in the analog recording mode. To solve this problem, if the user displays the control panel in an effort to try to record the digital broadcasting signal *that the user is watching*, and the recorder is in the analog recording mode, the digital input picture will not be displayed, and, for example, will be shown as a "gray" signal as indicated in Fig. 4A.

Thus, combining the cited prior art does not produce the claimed invention of the Group A claims as now presented. Applicants therefore request that the rejection of the Group A claims be withdrawn.

#### Group B Claims (Independent Claims 35 and 53)

The Examiner has rejected the independent claims 35 and 53, and dependent claims 54-57 (now cancelled), as obvious only over Akamatsu (claim 35) or Akamatsu and Sparks (claim 53). The Examiner has also rejected dependent claims 36-37 as obvious in view of Akamatsu, Sparks, Ohara and Knudson, and Applicants have now cancelled dependent claims 36-39. The Examiner addresses claim 35 at pages 5-6 of the Official Action and claim 53 at pages 8-9 of the Official Action.

As to claim 35, the Examiner relies upon Akamatsu for disclosing all of the claim limitations except the last limitation, and for disclosing a portion of the last limitation of "displaying an alarm message upon an attempted reproduction

of a program recorded in the analog mode ...", but admits that Akamatsu lacks displaying such an alarm message "*when the external reproducing apparatus is in the digital reproduction mode.*" (Official Action at 6.)

However, Akamatsu lacks the feature of the Group B claims as currently presented of:

"displaying an alarm message during a recording mode of the external reproducing apparatus *indicating that a new station of the digital broadcasting signal cannot be selected during display of a control panel* normally allowing a user to select a new station, *during (i) digital recording, and (ii) analog recording modes of stop, recording pause and record, by the external reproducing apparatus*"

The Examiner cites to Figs. 38 and 9 of Akamatsu for disclosing the feature of displaying alarm messages, but these figures relate to the display of warning messages either (1) when the reserved time set by timer arrives during recording or reproduction (Fig. 38; col.6 ll.22-25; col.26 ll.1-4) or (2) when there are overlapping reservations made (Fig. 9; col.5 ll.8-10; col.11 ll.52-55). Akamatsu does not generate alarm messages about the ability to selecting new stations depending on whether the control panel for changing stations is displayed or not and on the analog or digital recoding modes of the external recording apparatus.

Applicants disagree with the Examiner's premise that notwithstanding the fact that Akamatsu lacks displaying an alarm when in the digital reproducing mode, it would have been obvious to "use the two features [i.e., alarms and digital reproduction of Akamatsu] in conjunction with each other to alert the viewer to an error in mode choice. To the contrary, given all the alarms disclosed in Akamatsu, there is no indication that there is even a problem that needs to be addressed via alarm warnings when the recording media is an analog recording but the external

recording apparatus is in a digital reproduction mode. This is because Akamatsu is concerned with *timer related errors*, not recording media errors. This problem was recognized by Applicants and arises when, for example, the input to the TV is digital and the user expects an output from the user's combined digital/analog VCR to the TV, yet the recording medium in the external VCR happens to be analog without this being known to the user.

With the present invention of the Group B claims, the user is warned that the program is an analog recording. Through this warning, the use can change the input to his/her TV, e.g., from input 7 from the IRD handling digital reproduction to analog input 9 (see Fig. 1). Still further, the present invention of Group B displays another type of warning about changing channels based on specific types of analog or digital recording modes, again another problem associated with whether the user is recording to a digital or analog medium in a combined analog/digital external recording apparatus.

Sparks also does not disclose preventing the display of digital broadcasting signals during analog recording. Sparks has an analog recording mode where the DVCR 200 records analog input signals. It can then output such analog signals to the display 300. An on-screen display (OSD) information can be mixed in with the signal, either by the DVCR 200 or IRD 100, to be output to the display 300. However, when Sparks is in the analog recording mode, there is no prevention of the display of the A/V OUT signal 101 when control panel (or OSD) information is displayed. Again, this is because Sparks, like Ohara, does not address the problem solved by Applicants; namely, that users may become confused if they try to record a digital broadcasting signal *being decoded and viewed* using a combined external digital/analog recording device, when that combined recording

device is in the *analog recording mode*.

As to Knudson, this reference relates to recording programs from an on-screen guide, and can display an informational message to the user that "recording is about to begin" (Fig. 3 and col. 7) and asks for confirmation whether the user wants to continue recording. Knudson does not disclose warning the user about changing channels, let alone providing warnings only in certain circumstances relating to the type of recording (e.g., analog or digital) of the external recorder that can record in either digital or analog format, and based in the given recording mode of the recorder (e.g., stop, pause or record).

Accordingly, because the cited prior art, alone or taken together, lacks the presently claimed station alarm displaying step of the claims and also does not render obvious the recording mode alarm displaying step, Applicants therefore request that the rejection of the Group B claims be withdrawn.

**Group C Claims (Independent Claims 52, 58, 63 And 72)**

Finally, as to the Group C claims, the Examiner has rejected independent claims 52, 58, 63 and 72 as obvious over a combination of Akamatsu, Sparks, Ohara and Hashimoto. Dependent claims 59-62 and 64-67 have also been rejected on these grounds.

The Examiner notes that Akamatsu does not teach that "the digital broadcast signal is displayed" but that Sparks teaches this at paragraph [0008]. (Official Action at 13.) The Examiner also notes that Sparks teaches a display processing circuit for displaying, citing to the processing with DVCR 200. (*Id.* at 14.) However, the feature being claimed by Applicants is the receiving apparatus "displaying the information associated with the program recorded on the recording medium loaded in said reproducing apparatus by a predetermined format."

Namely, such associated information about the recorded program itself includes, for example, items such as channel number of the program, program name, genre, date of the recording, and the recording time (see, e.g., dependent claim 59). This feature is not disclosed in either Akamatsu or Sparks. Thus, display of the digital broadcasting digital is not the function being claimed.

Further, Akamatsu lacks this feature in that its on-screen display, for example the display of Fig. 27, does not show information associated with the program already recorded on the recording medium, just information associated with the medium itself (is the medium absent or present; what space is left on the medium), the condition of the recording apparatus (is it is stop, record or reproduction mode) and the reservations (are they set or not set).

As to the remaining limitation of claim 52, the Examiner again notes that, based on Hashimoto, it would have been obvious to "modify the combined teaching with displaying of an alarm if an input/output that is inconsistent with the replay mode so as to notify the user of any problem that may arise in program recording or reproduction." (Office Action at 14.)

But modifying Akamatsu and/or Sparks with Hashimoto does not produce the claim limitations of the Group C claims. In Hashimoto, no error or alarm message is shown upon any attempted reproduction by the IRD of a digitally recorded program due to the inability to decode the signal in the IRD. The claims of Group C specify that there is a program recorded on the recording medium but that it cannot be decoded in the decoder. Hashimoto does not even disclose a solution to the problem of the inability to decode a properly recorded program by the decoder. Rather, the portion of Hashimoto cited by the Examiner is concerned with adjusting the picture of the input



video signal and merely presents error messages if no video signal is present (Fig. 14B) or if its scanning frequencies are out of range (Fig. 14A).

The prior art references, even if combined, therefore do not meet the limitation (e.g., claim 52) of: "wherein in the case where a digital signal reproduced by said reproducing apparatus and received through said digital interface *is not able to be decoded in said decoder*, said display processing circuit performs a display process so as to display a message *showing that the program recorded on the recording medium loaded in said reproducing apparatus is recorded in a recording mode* in which said digital signal cannot be decoded by said receiving apparatus of said digital broadcasting."

Thus, Applicants request that the rejection of the Group C claims also be withdrawn.

In view of the above, it is respectfully submitted that these amendments and remarks place the application in condition for immediate allowance. If, however, for any reason the Examiner does not believe such action can be taken, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any objections which he may have.

Application No.: 09/600,003

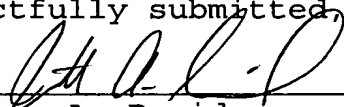
Docket No.: SONYSU 3.3-086

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge applicants' Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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